

REMARKS

Claims 1 and 2 are amended. No new subject matter is added. Claims 1-20 remain pending in the application. Reconsideration and allowance of the pending claims is requested in light of the following remarks.

Claim Amendments

The amendment of claim 1 is fully supported in the application as filed at, e.g., previously presented claim 2. Since claim 1 is amended to include features that were previously recited in claim 2, the amendment of claim 1 is not one which requires further consideration and/or search.

Claim 2 is amended for consistency with claim 1.

Claim Rejections - 35 U.S.C. § 102

Claims 1 and 3-4 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,607,955 to Lee (“Lee”). The applicant disagrees.

Regarding claim 1, the claim recites, *inter alia*, patterning the wire line layer to form bit lines. Contrary to this feature, Lee states that the alleged wire line layer 102 shown in FIG. 3A is in actuality a gate electrode layer 102 (column 6, lines 15-17). A gate electrode is not identically the same as a bit line. For at least this reason, Lee fails to anticipate claim 1 because it does not show the identical invention in as complete detail as contained in the claim. MPEP 2131.

Claim 3 depends from claim 1, and inherently contains the features of claim 1. Consequently, Lee does not anticipate claim 3 for at least the same reasons it fails to anticipate claim 1. MPEP 2131.

Claim 4 recites, *inter alia*, forming a metal layer, the metal layer consisting of a metal (emphasis added). The Office Action proposes that the metal silicide layer 103 of Lee is a metal layer consisting of a metal. To the contrary, MPEP 2111.03 states “[t]he transitional phrase ‘consisting of’ excludes any element, step, or ingredient not specified in the claim.” Consequently, the language of claim 4 explicitly excludes a metal silicide layer, because a metal silicide layer include an ingredient not specified in the claim. For at least this reason, Lee fails to anticipate claim 4 because it does not show the identical invention in as complete detail as contained in the claim. MPEP 2131.

Claim Rejections - 35 U.S.C. § 103

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being obvious over US Patent No. 7,056,786 to Yun, et al. (“Yun”) in view of Lee. The applicant disagrees.

Yun constitutes prior art under 35 U.S.C. 102(e) as of its earliest U.S. filing date, or 23 January 2004. MPEP 2136. The filing dates of foreign applications may not be used as 35 U.S.C. 102(e) dates for prior art purposes. MPEP 2136.03, emphasis in original.

Yun does not constitute prior art under any one of 35 U.S.C. 102(a), (b), (c), or (d). MPEP 2132, 2133, 2134 and 2135. Thus, Yun qualifies as prior art only under 35 U.S.C. 102(e), (f), or (g).

According to 35 U.S.C. 103(c), subject matter developed by another which qualifies as prior art only under 35 U.S.C. 102(e), (f), or (g) may be disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” MPEP 706.02(l)(1), 2146.

Yun and the claimed invention have the same assignee, namely, Samsung Electronics Co., Ltd. Furthermore, at the time the invention was made, it was subject to an obligation of assignment to Samsung Electronics Co., Ltd. Consequently, Yun is disqualified as prior art for purposes of a 35 U.S.C. 103 rejection. 35 U.S.C. 103(c).

The applicant therefore requests that the rejection of claims 1-20 as obvious under 35 U.S.C. 103 in light of the combination of Yun and Lee be withdrawn.

Double Patenting

Claims 1 and 3-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of Lee. It is alleged that although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent are commensurate in scope with those of the instant invention.

As stated by the Office Action, a non-statutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is either anticipated by, or would have been obvious over, the reference claim(s).

The Office Action has already recognized that Lee’s claims are not identical to claims 1 and 3-4 of the present application. Thus, claims 1 and 3-4 are not anticipated by Lee’s claims

because they fail to show the identical invention in as complete detail as contained in the claim. MPEP 2131.

Furthermore, a double patenting rejection of the obviousness-type is analogous to the nonobviousness requirement of 35 U.S.C. 103 except that the patent principally underlying the double patenting rejection is not considered prior art. MPEP 804(B)(1). Any analysis employed in an obviousness type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. MPEP 804(B)(1).

Any obviousness type double patenting rejection should make clear (A) the difference between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in the claim in the patent. MPEP 804(B)(1).

The Office Actions fails to do either of these things. As the court in *Vogel* recognized, “it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim.” MPEP 804(B)(1), *citing In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

One glaring difference between claim 1 of Lee and claim 1 of the present application is that the applicant, as an initial matter, first deposits a wire line layer before performing subsequent steps (depositing hard mask layers, etching the hard mask layers, etc.) that ultimately results in the patterning of the wire line layer to form wire lines. Lee, on the other hand, appears to “[fill] the exposed semiconductor substrate with a conductive material” only after the interlayer insulating layer has been etched with a self-aligned contact mask (claim 1). Thus, claim 1 of Lee and claim 1 of the instant invention are directed at substantially different methods of forming contacts, and for at least this reason claim 1 of the instant invention is not merely an obvious variant of Lee’s claim 1.

Thus, not only does Lee’s claim 1 fail to teach all the features recited in applicant’s claim 1, there also appears to be no suggestion or motivation to modify Lee’s claim 1 to arrive at the method claimed by the applicant. In a 35 U.S.C. 103(a) analysis, the failure to achieve any one of these requirements indicates that a *prima facie* case of obviousness does not exist. MPEP 2143.

For the above reasons, the obviousness-type double patenting rejection is traversed.

Conclusion

For the reasons presented above, reconsideration and allowance of the pending claims is requested. Please telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Todd J. Iverson
Reg. No. 53,057

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613

Customer No. 20575